

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRENT D. HENNINGSON,
WILLIAM C. CATELLIER,
and JOSHUA D. STALLER

Appeal No. 1998-1898
Application 08/497,721¹

ON BRIEF

Before BARRETT, RUGGIERO, and DIXON, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed June 30, 1995, entitled "System And Method For Call Handling."

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This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-3, 5, and 7-10. Claims 4 and 6 have been canceled.

We reverse.

BACKGROUND

The disclosed invention relates to a telephone call forwarding system.

Claim 1 is reproduced below.

1. For use in an Advanced Intelligent Network (AIN) provided with, for each subscriber, (a) a subscriber Service Number, (b) a subscriber Calling Number, and (c) a subscriber Call Forwarding Profile including a plurality of Destination Numbers each assigned a calling day, a calling time, and a calling priority designation, an automated call handling method for enabling a caller to dial a single telephone number and reach a subscriber at one of a plurality of separate locations, comprising:

generating a call to a subscriber by dialing a subscriber Service Number;

processing the call to determine the calling day and the calling time of the call and the subscriber Service Number;

processing the subscriber Service Number to identify the subscriber Call Forwarding Profile corresponding to the subscriber Service Number to generate (a) a list of Destination Numbers to route the call, and (b) a corresponding routing order with respect to the calling day and the calling time of the call;

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comparing the calling day and the calling time of each Destination Number of the subscriber Call Forwarding Profile to the calling day and the calling time of the call;

selecting each Destination Number whose calling day and calling time match the calling day and the calling time of the call; and

sequentially routing the call to the selected Destination Numbers in accordance with their calling priority designations.

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The Examiner relies on the following prior art:

U S WEST ROLLS OUT AIN VARIETY PACK, Advanced
Intelligent Network (AIN) News, June 15, 1994, V. 4,
No. 12 (Dialog database printout) (hereinafter referred
to as the "AIN News article").

Claims 1-3, 5, and 7-10 stand rejected under 35 U.S.C.
§§ 102(a) and 102(b) as being anticipated by a public use or
sale of the invention as evidenced by the AIN News article.

We refer to the Final Rejection (Paper No. 9) (pages
referred to as "FR__") and the Examiner's Answer (Paper
No. 21) (pages referred to as "EA__") for a statement of the
Examiner's position, and to the Brief (Paper No. 18) (pages
referred to as "Br__") and the Reply Brief (Paper No. 22)
(pages referred to as "RBr__") for a statement of
Appellants' arguments thereagainst. The Examiner notes
entry of the Reply Brief, but does not respond to the merits
thereof (Paper No. 24).

OPINION

Initially, we note that under 35 U.S.C. § 102(a)
nothing an applicant who has invented in the United States
does can preclude him from getting a patent under this
subsection because § 102(a) refers to acts "before the
invention thereof by the applicant." See In re Katz,

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687 F.2d 450, 454, 215 USPQ 14, 17 (CCPA 1982) ("But certainly one's own invention, whatever the form of disclosure to the public, may not be prior art against oneself, absent a statutory bar." [Emphasis in original.] (Citing In re Facius, 408 F.2d 1396, 1406, 161 USPQ 294, 302 (CCPA 1969).)). Furthermore, § 102(a) does not relate to "public use or on sale." Accordingly, § 102(a) is not a proper statutory basis for rejection in this case and the Examiner's rejection, to the extent it relies on § 102(a), is reversed.

The AIN News article, which was published before the critical date, indicates that a "FindMe" service, which provides "alternate location forwarding (three possible locations) . . .," and a "Scheduled Forwarding" service, which "provides time-of-day/day-of-week routing . . ." are scheduled for trial. The AIN News article quotes Mr. Henningson, one of the co-inventors on this application, as stating that U.S. West is "getting into the marketplace" and is "offering the services now." The AIN News article provides no details of how these two services would work and the Examiner has not attempted to reject the claims on the

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description in the article using the article as a § 102(b) printed publication. Instead, the Examiner relies on the AIN News article as prima facie evidence that the claimed subject matter was in "public use" or "on sale." Appellants admit that "[t]he Examiner is correct in positing that the AIN news article is a prima facie [case] of public use and on sale activity" (Br6). However, Appellants indicate that Mr. Henningson was ignorant of the construed meanings of his statement in the context of what actually occurred (Br6) and have submitted Exhibits A-F and a Declaration by co-inventor William C. Catellier as evidence to rebut any prima facie case of public use or on sale activity of the claimed invention prior to the critical date.

We agree with Appellants' arguments in the Brief that the evidence clearly establishes that there was no public use or on sale activity of the claimed subject matter prior to the critical date. We adopt Appellants' reasons as our own. In addition, we provide the following comments.

Appellants have introduced persuasive evidence that there was no sale or offer for sale of the claimed invention before the critical data. Importantly, the participants in

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the technical trial were not charged for their participation (Exhibit A; Exhibit B, p. 1; Exhibit C, p. 3; Declaration, para. 11). Thus, we fail to see how there has been a sale or offer to sell during the trial period. None of the trial participants were offered special treatment when the final version of the service was offered to the public (Exhibit B, p. 3; Declaration, para. 21). This indicates to us that there was no marketing motive to the test, i.e., that there was no intent to gain a market advantage by gathering customers before actual selling of the services.

Participation was limited to a trial group of 40 persons (Declaration, para. 9) as compared to an estimated 70,000 potential customers (Declaration, para. 22). Thus, there was no attempt to use the trial as a market trial to judge consumer demand. The draft letter regarding PERSONAL ACCESS SERVICE [PAS]-TECHNICAL TRIAL LETTER OF UNDERSTANDING between participants and U S WEST Communications, Inc.

(USWCI) indicates (Exhibit B, p. 2): "USWCI will provide PAS to Customer with the intent of testing and evaluating the technical feasibility, technology, operational effectiveness of PAS prior to placing PAS in a Market Trial

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and/or an offering into the market place." This indicates that an offer for sale would come at some time in the future, after the technical trial. The letter by attorney Timothy R. Schulte dated June 9, 1995, (Exhibit E) states: "This ['Find Me'] service was market trialed starting July 5, 1994. Therefore, please file this application prior to July 5." (Emphasis omitted.) Also, Mr. Catellier's Declaration states that "market testing started with a market trial in Seattle and Phoenix on July 5, 1994" (Declaration, para. 19). This indicates that commercialization began on July 5, 1994, after the critical date. In summary, the evidence indicates that the claimed subject matter was not "on sale" prior to the critical date.

Appellants have introduced persuasive evidence that the purpose of the technical trial prior to the critical date was experimental. "The use of an invention by the inventor himself, or of any other person under his direction, by way of experiment, and in order to bring the invention to perfection, has never been regarded as [a public] use."

City of Elizabeth v. American Nicholson Pavement Co.,
97 U.S. 126, 134 (1877); T.P. Lab., Inc. v. Prof'l

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Positioners, Inc., 724 F.2d 965, 971, 220 USPQ 577, 582 (Fed. Cir. 1984). The draft letter of understanding indicates (Exhibit B, p. 2): "USWCI will provide PAS to Customer with the intent of testing and evaluating the technical feasibility, technology, operational effectiveness of PAS prior to placing PAS in a Market Trial and/or an offering into the market place." This clearly indicates the intended experimental nature of the technical trial. The purpose was to evaluate the hardware, software, and design of components in a live network environment (Declaration, paras. 7 and 8). Because of the nature of the invention, the testing had to be conducted under the supervision and control of the inventors or the assignee. The participants all signed non-disclosure agreements (Declaration, para. 10); we note also that the bottoms of the pages of Exhibit C state that it is not for use or disclosure outside of U S WEST. The use of non-U S WEST personnel in the technical trial (the EXTERNAL CUSTOMERS noted in Exhibit C) does not void an experimental use. In summary, the evidence indicates that the purpose of the technical trial was

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experimental and, thus, the claimed subject matter was not "in public use" prior to the critical date.

The Examiner notes that Exhibit A discloses that as of May 4, 1994, the service was "scheduled to be available to customers residing in the Seattle Metro area" (Exhibit A, p. 1) and "[t]he Examiner interprets this as a marketing strategy, whereby the claimed invention is offered on a trial basis to determine whether the service meets the customer's needs" (FR5). Exhibit A, dated May 3, 1994, and having a first facsimile transmission date of May 4, 1994, states that "on June 28th [the FindMe service] is scheduled to be available to customers residing in the Seattle Metro area." However, there is no evidence that the service was actually commercially available, as planned, on June 28th (which would have been before the critical date). The evidence is that market testing did not begin until July 5, 1994 (Exhibit E; Declaration, para. 19). Exhibit A does not indicate that the "trial basis" is a sale or offer for sale of the FindMe service or that it is anything other than an experimental use.

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The Examiner states that Exhibit B establishes "public use" and "on sale" activity because: "The bottom of page 1 of Exhibit B refers to the customer cooperation 'with USWCI in its PAS market research.' On line 4 of page 2, reference is made to a 'Market Trial and/or an offering into the market place.'" Customer cooperation with market research does not indicate commercialization during the technical trial period. As to the statement on page 2, the complete sentence on lines 1-4 states: "USWCI will provide PAS to Customer with the intent of testing and evaluating the technical feasibility, technology, operational effectiveness of PAS prior to placing PAS in a Market Trial and/or an offering into the market place." This indicates the purpose of the technical trial is technical experimentation and is to be followed at some later date by a market trial, not that the purpose is for marketing.

The Examiner states that Exhibit C establishes "public use" and "on sale" activity because of (1) the price lists and list of "EXTERNAL CUSTOMERS" more than one year before the filing date; and (2) "page 4 of Exhibit C discloses that 'any technical trial subscriber who continues with the

service through market trial will begin to billed for the product" (emphasis in original). There is no indication in Exhibit C that the price lists indicate an offer to sell the service during the technical trial; the prices are apparently prices that will be charged in the subsequent market trial. The statement on page 4 indicates that the service will be "on sale" in the market trial. However, the market trials did not begin until July 5, 1994.

In regard to Exhibit F, the "U S WEST® FindMe**K** Service Instruction Manual," dated "6/94," is evidently the "FindMe Service user-guide" mentioned in Exhibit A, which was distributed to users during the technical trial (Br7). Nothing is known about the public availability or confidentiality of this manual so as to be able to determine whether it constitutes a § 102(b) "printed publication." The manual provides details about the FindMe service that are not found in the AIN News article. Appellants are required to provide, for the record, a description of the circumstances surrounding the public accessibility of Exhibit F for evaluation by the Examiner. Our decision does not address Exhibit F.

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For the reasons stated above, we conclude that Appellants have rebutted any prima facie case of public use or on sale activity of the claimed invention prior to the critical date. The rejection of claims 1-3, 5, and 7-10 is reversed.

REVERSED

	LEE E. BARRETT)	
	Administrative Patent Judge)	
)	
)	
)	BOARD OF
PATENT)	
	JOSEPH F. RUGGIERO)	APPEALS
	Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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